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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,678	04/09/2001	William W. Cimino	40206.1USC1	2591
23552	7590	01/05/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			THISSELL, JEREMY	
			ART UNIT	PAPER NUMBER
			3763	
			DATE MAILED: 01/05/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/829,678

Applicant(s)

CIMINO, WILLIAM W.

Examiner

Jeremy T. Thissell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 December 2003 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Mackool (US 5,354,265).

Mackool teaches a continuous sleeve 18 as claimed, wherein the sleeve can be made out of rigid plastic or "other suitable material" (col. 5, lines 26-28).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mackool (US 5,354,265) in view of Hood et al (US 5,746,713).

Mackool teaches all the claimed subject matter except for the sleeve being made out of metal. Hood teaches a similar sleeve wherein it can be made out of either rigid plastic or metal (col. 3, lines 44-45). In view of Mackool's teaching that "other suitable material" can be used for the sleeve, it would have been obvious to one of ordinary skill in the art to use metal as taught by Hood to make the device of Mackool, particularly since Hood teaches the interchangeability of metal with rigid plastic.

***Response to Arguments***

Applicant stated that the issue in this case is "... whether it is proper to define the claimed 'protective sheath' by limitations relative to the unclaimed 'elongate ultrasonic probe.'" However, the examiner contends that the issue is more specific than that. The issue has three parts to it. First, it must be determined whether it is proper, under 35 U.S.C. 112, to claim a positively recited element using limitations describing it relative to an unclaimed element. Second, if the claim language is, in fact, determined to be proper under 35 USC 112, whether the claimed functional (relative) language

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structurally limits the positively claimed subject matter. And, third, whether these limitations (if any) obviate the prior art under both 35 USC 102 and 103.

The instant claims satisfy the first two prongs of this analysis but fall short with regard to the third prong. Applicant has cited Orthokinetics and Moore for their holdings that relative language as found herein is indeed proper under 35 USC 112. The examiner agrees that the instant claims are proper under 35 USC 112. However, neither the Orthokinetics case nor the Moore case offers a particularly pertinent discussion on whether that type of language carries patentable weight.

Here, the relative language only limits the size of the sheath, but not to any particular size. Further, comments have been made by the examiner, applicant, and even in the Orthokinetics decision to the effect of such changes in size being routine for one of ordinary skill in the art.

Lastly, Orthokinetics offers a minimal discussion about the differences between the prior art. On page 1089 onto page 1090, Ortho describes the differences as follows: "it is undisputed that there are at least these differences: the combination of legs as lever for loading the chair into an automobile and the retraction of the rear wheels by the attendant while the patient remains in the chair." Thus, the court makes no mention of sizing relative to any particular vehicle(s), which was the limitation in question regarding 35 USC 112. That is to say that the court did not view the sizing limitation as differentiating the claims from the prior art, despite being proper under 35 USC 112. That is NOT to say that such relative limitations would never make the deciding difference, just not in the Orthokinetics case, and similarly not in this case.

In the end, the instant claims still claim merely a tube of reasonable length and diameter with a connection means. That is what is shown in applicant's own drawings and that is what is shown in and therefore anticipated by Mackool.

### ***Conclusion***

This is a RCE of applicant's earlier Application No. 09/829,678. All claims are drawn to the same invention claimed in the earlier application and were finally rejected on the grounds and art of record. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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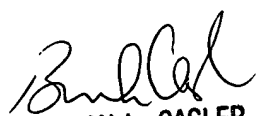
**Contacts**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy T. Thissell whose telephone number is (703) 305-5261. The examiner can normally be reached on 8:30-7:00 Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached at (703) 308-3552. The fax phone numbers for all fax communications is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

jt  
January 4, 2004

  
BRIAN L. CASLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700